

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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From: Applicant Y. Freedland
To: The Honorable Examiner Ira Lazarus Senior Petition Reviewer; and
The Honorable Linda Sholl, Special Programs Examiner
Re: Split-Nut Precision Fasteners, Application Serial Number 09/753,128
Sent: Via Fax to (571) 273-4791 and (703) 872-9306
Via Mail to: Mail Stop Petitions
Commissioner for Patents
P.O.B. 1450
Alexandria, VA 22313

**RE: Petition to Withdraw Holding of Abandonment
on Patent Application 09/753,128 under 37 CFR 1.181**

Sir,

Please find enclosed:

1. Petition to Withdraw Holding of Abandonment on Patent Application 09/753,128 under 37 CFR 1.181, eight pages.
2. January 26 2004 Request for Telephonic Communication to SPE Bennett;
3. January 27, 2004 Confirmation of Telephonic Communication to Examiner Odland;
4. February 3, 2004 cover for material to be considered during February 4, 2004 Telephonic Communication;
5. February 3, 2004 POA; and
6. Receipt for items 1-6 to be mailed to Applicant.

Applicant respectfully awaits a positive reply to the instant Petition to Withdraw Holding of Abandonment, a positive Office Action on the merits of Applicant Response of July 5, 2004 and notice of Allowance of the Instant Application.

Respectfully Submitted,

Y. Freedland, May 22, 2005
Y. Freedland
Inventor and Applicant

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Petition to Withdraw Holding of Abandonment on Patent Application 09/753,128
under 37 CFR 1.181

Sir,

The facts pertinent to the Instant Petition are as follows:

I. March 7, 2003:

Examiner Ferko, later known as Examiner Odland, sends an Office Action requesting Election of Species.

II. April 22, 2003

Examiner Ferko sends a Non Final action accepting the Election of Species and cites prior art of Goble, US Patent 5,702,397 against the instant Application.

III. August 21, 2003:

Applicant sends pro se Response to April 22, 2003 Office Action, inter alia, rejecting Goble who teaches a fastener that does *not* contact a forward tissue surface. In distinct contrast, the instant invention teaches a fastener whose forward surface *secures against a tissue surface*.

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IV. September 9, 2003

Examiner Ferko mails a Final Office Action that *accepts* Applicant arguments against Goble, US Patent 5,702,397, but cites *new prior art*, Seegmiller US Patent 5,525,013 who also teaches a fastener that again *does not* contact a forward surface and, due to its industrial size and materials, cannot be used in the body.

Applicant, presently, respectfully submits that the Action of September 9, 2003 should have been classified as "Non-Final" because the Action cites *new prior art* contrary to MPEP 706 recommendation:

"The goal of examination is to clearly articulate rejections *early* in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity."

V. November 23, 2003:

Applicant files an Amendment, including a revocation of Power of Attorney (POA) of Rick Matos of Plano Texas and appoints Paul Fenster et al as attorneys, of mailing address Roy N. Envall, Jr. of Arlington, Virginia.

The Seegmiller prior art suggests that Examiner Ferko requires additional proof that the instant invention contacts a forward tissue surface and the Amendment references Figures and description from Application PCT/IB00/00364 included by reference.

VI. December 09, 2003:

USPTO Representative Leneetha L Dyar mails to Rick Matos in Plano Texas, a rejection of the POA of November 23, 2003 based upon failure to provide an *assignee* POA under 37 CFR 3.73(b).

Applicant recently finds the POA rejection in the USPTO file wrapper and submits, presently, that the rejection is in error because there is *no assignee* in the instant Application.

VII. January 09, 2004:

Examiner Odland mails an Advisory Action to Rick Matos of Plano Texas that rejects the reference to the Foreign Application on the basis of MPEP 608.10:

"In any application which is to issue as a US Patent, essential material may not be incorporated by reference to patents or applications published by Foreign Countries."

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Applicant telephonically contacts Examiner Odland who states that MPEP 608.10 is a *blanket* prohibition against not only *referring* to material included in a Foreign Application by reference, but *even drafting* portions of the Foreign Application into the instant Application.

Applicant, presently, respectfully disagrees with the interpretation by Examiner Odland because MPEP 608.10 also states that material from foreign filings incorporated by reference *may indeed* be considered if *drafted directly* into the instant Application:

"Applicant is required to amend the disclosure to include the material incorporated by reference."

Examiner Odland states that to have further Telephonic Communication, Applicant must send a POA establishing Applicant as the sole representative of the instant Application.

VIII. January 26 and 27, 2004:

January 26, 2004, Applicant requests Telephonic Communication with Supervisory Patent Examiner (SPE) Bennett (copy enclosed); and

January 27, 2004, Applicant confirms scheduling of Telephonic Communication on February 4, 2004 with Examiner Odland (copy enclosed).

IX. February 3-4, 2004:

On the basis of the above interpretation of MPEP 608.10 and in preparation for the Telephonic Communication, Applicant faxes the following items to Examiner Odland that are not entered in the USPTO filewrapper:

1. POA electing the Applicant to serve Pro Se (copy enclosed);
2. Cover Letter Confirming a Telephonic Conversation to take place February 4, 2004 (copy enclosed); and
3. Response to Advisory Action of January 09, 2004 that deletes reference to Application PCT/IB00/00364 and quotes from U.S. Patent No. 6,162,234, also included by reference. U.S. Patent No. 6,162,234 also proves, inter alia, that the instant invention contacts a forward surface.

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X. February 28, 2004:

Applicant participates pro se in a first Telephonic Communication with both Examiner Odland and SPE Bennett providing prima facie proof of acceptance of the POA of February 3, 2004.

Examiner Odland agrees that description included by reference from U.S. Patent 6,162,234 proves that the instant invention contacts a forward tissue surface and, at no time during the Communication informs Applicant that Reply Period expired on December 9, 2005.

Applicant files a Telephonic Communication Summary, of record that, inter alia, states:

"Applicant is responding pro se [under POA] submitted February 3, 2004 and requests that correspondence be addressed to the [Israel] address listed below."

In spite of accepting the POA of February 3, 2004 as a basis for the Telephonic Communication of February 4, 2004, Examiner Odland continues to address Rick Matos and mails the Office Actions to Plano Texas, rather than, in the very least, addressing Dr. Yosef Freedland c/o the Plano Texas address.

XI. April 19, 2004:

Examiner Odland issues an Advisory Action, again to *Rick Matos of Plano Texas*, and rejects agreement with reference to U.S. Patent No. 6,162,234 reached on February 28, 2004.

Additionally, Examiner Odland cites a new argument that "applicant has not positively claimed a suture".

XII. May 04, 2004:

Applicant participates in a second Telephonic Communications with Examiner Odland and SPE Bennett. SPE Bennett Applicant agrees to consider a new Response that drafts material from Foreign Application PCT/IB00/00364 into the instant Application, as alluded to in the Telephonic Summary:

"SPE Bennett who suggested that Applicant *file a new response* to the above-noted Advisory Action and that he [SPE Bennett] would review the response..."

Again, at *no time* during the Telephonic Interview is Applicant informed that Reply Period had expired on December 9, 2005

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XIII. May 11, 2004:

Applicant files a Response that drafts material from Foreign Application PCT/IB00/00364 into the instant Application and a Telephonic Communication Summary of record that inter alia states:

"Applicant is responding pro se [under POA] submitted February 3, 2004 and requests that correspondence be addressed to the [Israel] address listed below."

Additionally, Applicant includes a new POA of record.

XIV. June 15, 2004:

SPE Bennett incorrectly reviews a Response that quotes U.S. 6, 162,234, rather than the Response of May 11, 2004 that drafts portions of Foreign Application PCT/IB00/00364 into the instant Application.

The resultant Advisory Action additionally introduces a *new* argument *above and beyond* the arguments that were *already* cited against the same Response on an earlier occasion, namely that the correct claim language should be: "adapted to contact tissue".

The Advisory Action specifically refers to the Telephonic Summary of the May 4, 2004, clearly accepting both the Change of Address and the POA but, yet again, the Advisory Action is addressed to Rick Matos and mailed to Plano Texas.

XV. July 05, 2004:

Applicant submits a Response that amends the claim language according to the Advisory Action of June 15, 2004 and, in honoring protocol to "respectfully" request examination, does not mention the error in failing to consider the correct Applicant Response that quotes Application PCT/IB00/00364.

Response is filed in the USPTO file wrapper as an "*Amendment after Non-Final Rejection*", confirming Applicant assumption throughout the majority of the proceedings that Responses were filed as amendments "After Non Final Rejection". Applicant awaits a new Response.

Examiner Odland *resigns* from the USPTO soon thereafter, compromising Applicant's ability to determine the basis for the delay in issuing an Office Action.

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XVI. February 7, 2005:

A Notice of Abandonment is addressed to Rick Matos and mailed to Plano Texas.

XVII. May 11, 2005:

Unaware of the Notice of Abandonment, Applicant puts finishing touches on response on related US Application 10/169,062 that requires the Instant Application be presently pending.

On routine examination of USPTO File Wrapper, Notice of Abandonment is found and the following actions are immediately initiated by Applicant:

1. Roy of the Inventor's Assistance Desk is contacted. Roy comments that there *must be a mistake* in the Abandonment classification and advises Applicant to contact Examiner.
2. Newly assigned Examiner Ragonese is contacted and Applicant is advised to contact Ira Lazarus, Senior Examiner in USPTO Office of Petitions.
3. Examiner Lazarus is contacted by Applicant, who notes that a failure to honor a valid POA and Address Change would indeed compromise Applicant ability to respond. Examiner Lazarus advises Applicant to file a Petition to Withdraw Holding of Abandonment and expect review by Special Programs Examiner (SPE) Sholl.

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XVIII. Summary:

Many errors in Office Actions caused confusion that destroyed Applicant ability to properly prosecute the Instant Application, including:

1. August 21, 2003 failure to honor valid arguments against Seegmiller previously accepted by Examiner Odland against Goble.
2. November 9, 2003 introduction of new arguments in what was, apparently, a Final Office Action.
3. January 09, 2004 blanket rejection of Foreign Application material included by reference. **Had Applicant not faced this apparent incorrect interpretation of MPEP 608.10, the instant Application could have been correctly amended and accepted in a timely fashion.**
4. June 15, 2004 erroneously considering a non-current Response and introducing new arguments beyond those *previously* cited against the Response.
6. Classification of the July 05, 2004 Response as "Non Final" in the USPTO Filewrapper.
7. Failure to honor multiple submissions of POA and change in mailing address.

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XIX. Epilogue:

Based upon the above, Applicant respectfully requests that the Instant Application be granted the following:

1. Withdrawal of Holding of Abandonment;
2. Non-Final Rejection status;
3. Review of the Response of July 5, 2005;
4. Allowance of sufficient time for Applicant Response;
5. Pro se status recorded in the USPTO; and
6. Correct Applicant mailing address recorded in the USPTO.

Applicant respectfully awaits a positive reply to the instant Petition to Withdraw Holding of Abandonment, a positive Office Action on the merits of Applicant Response of July 5, 2004 and notice of Allowance of the Instant Application.

Respectfully Submitted,

_____, May 22, 2005

Y. Freedland
Inventor and Applicant

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4. February 3, 2004 POA.

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